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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,520	05/11/2005	John Anthony Bosley	J3696(C)	5086

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EXAMINER	
LILLING, HERBERT J	

ART UNIT	PAPER NUMBER
1657	

MAIL DATE	DELIVERY MODE
06/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/534,520	BOSLEY ET AL.	
	Examiner	Art Unit	
	HERBERT J. LILLING	1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-13* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 May 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Receipt is acknowledged of a preliminary amendment to the claims and a certified copy of foreign priority papers filed May 11, 2005; and a prior art information disclosure statement filed August 22, 2005.

2. Claims 1-13 are present in this application, which is a 371 of PCT/EP03/12206, filed October 27, 2003.

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-7, drawn to a method of producing a retinyl ester compound comprising subjecting a composition comprising retinol or a retinyl ester and a fat or oil of animal or vegetable origins to enzyme catalyzed transesterification in solvent free conditions to produce a retinyl ester, classify in Class 435, subclass 67.

Group II, claim 8, drawn to **a first product** of a mixture **of retinyl esters of fatty acids** prepared according to the method of claim 1, classified in Class 514, subclass 725.

Claim 10 will be examined with this invention.

Group III, claim 9, drawn to **a second product** which is a **composition of a mixture** of retinyl esters of fatty acids and containing a fat or oil, classified in Class 424, subclass 115.

Group IV, Claim 11, drawn to a **third product** which is a topical composition which contains retinyl esters of fatty acids classified in Class 424, subclass 60.

Claim 12 will be examined with Group IV invention.

Group V, claim 13, drawn to a method of providing at least one skin care benefit selected from: treating/preventing wrinkling, sagging, aged and/or photodamaged skin; boasting collagen deposition on skin, boosting decorin production in skin; soothing irritated, red and/or sensitive skin; improving skin texture, smoothness and/or firmness; providing anti-inflammatory benefits; enhancing skin differentiation; reducing sebum production; or the prevention or treatment of acne; comprising applying thereto a mixture of retinyl esters according to claim 8, classified in Class 424, subclass 401.

5. The above inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1 as indicated in view of the art of record in the PCT which clearly indicates that the inventions lack any inventive concept for the separated groups.

In view of the following the inventions are distinct, each from the other because of the following reasons:

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have been shown to have these differences as noted by the international search report. Because these inventions are independent or distinct for the reasons given above and

there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and **there would be a serious burden** on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, a different field of search and they have acquired a separate status in the art due to their recognized divergent subject matter as well as different computerized searches would be required for each of the above Inventions, restriction for examination purposes as indicated is proper.

Thus, the above restriction is proper according to the MPEP.

6. This application contains claims directed to the following patentably distinct species:

A. Whereby a method of producing a retinyl ester compound comprising subjecting a composition comprising:

1. retinol;

or

2. retinyl ester.

B. Whereby a method of producing a retinyl ester compound comprising subjecting a composition comprising:

x. fat or oil origin;

or

y. vegetable origin.

C. Wherein the source of the fatty acid is

a. kombo nut oil,

b. coriander oil,

c. sunflower oil,

d. safflower oil,

e. pomegranate seed oil,

f. Manketti nut oil,

g. fish oil, ----(This does not appear to be within the scope of claim 1)

h. borage oil,

i. pine nut oil,

j. Impatiens balsamina seed oil,

k. calendula seed oil.

l. other-including mixtures of above-please specify.

D. Whereby the method of providing at least one skin care benefit by applying a mixture of retinyl esters selected from the group consisting of :

1. treating/preventing wrinkling,

2. sagging, aged and/or photodamaged skin;

3. boasting collagen deposition on skin,

4. boosting decorin production in skin;

5. soothing irritated, red and/or sensitive skin;

6. improving skin texture,

7. smoothness and/or firmness;

8. providing anti-inflammatory benefits;

9. enhancing skin differentiation;

10. reducing sebum production;

11. the prevention or treatment of acne.

7. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 13 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

8. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. In accordance with this Tech Center Policy, rejoinder of non-elected claims will be in governed by the following paragraphs:

F.P.: Ochiai/Brouwer Rejoinder form paragraph

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

11. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is 571-272-0918 and Fax Number is **571-273-8300**. or SPE Jon Weber whose telephone number is 571-272-0925. Examiner can be reached Monday-Friday from about 7:30 A.M. to about 7:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit **1657**
June 07, 2007

Dr. Herbert J. Lilling
Primary Examiner
Group 1600 Art Unit 1657